

## R E M A R K S

### A. Summary of Status of Claims

Claims **33 and 34** are indicated as allowable if rewritten into independent form to include all the limitations of the independent claim from which they depend and all intervening claims.

Claims **1 – 55 and 65 – 68** are pending.

### B. Response to “Non-Responsive Amendment” Allegation

On April 21, 2005 the Examiner issued an Office Action rejecting all pending claims (the “April 21 OA” herein). In response, Applicants amended each of the independent claims by adding some features to the existing claims. Applicants also made separate arguments of patentability for some of the dependent claims. The Amendment and Response in which the amendments and arguments made in response to the April 21 OA were made is referred to as the “April 21 Response” herein.

On October 28, 2005, in response to the April 21 Response, the Examiner sent a Notice of Non-Responsive Amendment, asserting that the amended claims “are directed to an invention that is independent or distinct from the invention originally presented.” The Examiner has asserted that the invention of the originally presented claim and the currently amended claims are subcombinations disclosed as usable together in a single combination. The Examiner has informed Applicants, during a telephone interview held between the Examiner and Applicants’ representative Magdalena Fincham, that the amendment has been entered but the amendment was non-responsive. The Examiner has not responded to any separate arguments of patentability regarding the dependent claims.

On January 03, Applicants' representative Magdalena Fincham spoke with the Examiner's supervisor, Wynn Coggins. Upon reviewing Applicants' arguments (provided below) regarding the impropriety of holding that Applicants' April 21 Response was "non-responsive", Ms. Coggins informed Applicants' representative that Ms. Coggins agreed that the "non-responsive" holding was inappropriate and that Ms. Coggins has instructed the Examiner to examine the claims as amended in the April 21 Response, and to address Applicants' arguments made therein.

Provided below is a summary of Applicants' arguments regarding the impropriety of the "non-responsive" amendment allegation. Applicants respectfully request that the Examiner re-consider whether the April 21 Response was non-responsive and examine the claims as they are currently pending, including considering the arguments supporting patentability.

(1) The amendments to the independent claims filed in response to the April 21 Office Action merely narrowed broader claims, by specifying that the second consumer is not involved in the first transaction. The independent claims as originally filed were broad enough to cover both a scenario where the second consumer was involved in the first transaction and a scenario where the second consumer was not involved in the first transaction. Although the Examiner correctly noted that this particular limitation was not pending in a previously presented claim, there is no regulation or statute that Applicants are aware of that specifies that claims can only be narrowed during prosecution to an embodiment previously claimed.

(2) The Notice of Non-Responsive Amendment was based on an allegation that the originally claimed invention and the currently claimed invention are

subcombinations usable together. Applicants respectfully disagree: the originally claimed embodiments were merely a broader version of the currently claimed embodiments; two subcombinations are more akin to two broad claims or embodiments that do not have any common features but that are combinable into a combination. Such is not the case here because, as stated, the originally claimed embodiments are merely a broader version of the currently claimed embodiments. The Examiner's assertion appears to be in conflict with MPEP section 806.05(d), which states that "Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope..." In the present case, the two subcombinations do overlap in scope: the originally claimed embodiments are a broader version of the currently claimed embodiments.

(3) The MPEP specifies that it is the Examiner's burden to specify, in a sub-combination/sub-combination allegation, for a first sub-combination to "suggest utility other than with the other subcombination" (MPEP 806.05(d), Examiner Note 3 for form paragraph 8.16). In the Notice of Non-Responsive Amendment (page 2), however, the Examiner merely suggested a utility for the originally claimed embodiment (the first alleged sub-combination) that references back to the second alleged sub-combination (the currently claimed embodiment) and did not provide a suggestion for a utility other than with the other sub-combination, as is required ("the invention of the originally presented claims has separate utility such as a method and system that does not require the second consumer to not be involved in the first transaction as required by the currently amended claims.")

(4) MPEP 821.03 does not apply to the current situation because, had the features added in the amendment been added as dependent claims from independent claim 1 earlier in prosecution, they could not have been restricted out. “The practice set forth in this section is not applicable where... applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.”

(5) In issuing a Notice of Non-Responsive Amendment without addressing Applicants’ separate arguments of patentability regarding claims that have not been amended (e.g., claim 49), the Examiner failed to comply with the requirements of MPEP 821.03. This section states that even if an amendment is held to be non-responsive because claims have been added that are directed to an invention other than previously claimed, “A complete action on all claims to the elected invention should be given.” In the present case, Applicants provided numerous separate arguments of patentability regarding many claims that were not amended in April 21 Response the Examiner has not provided any response or action regarding these arguments.

While the Examiner did not respond in any detail to the merits of Applicants’ arguments, the Examiner did inform Applicants that he did not find them persuasive. The Examiner further stated that he consulted with Primary Examiner Yogesh Gorg in reaching the conclusion that the arguments were not persuasive but did not provide any reasoning as to why Applicants’ arguments were not persuasive. Accordingly, Applicants would appreciate a clarification of the Examiner’s position with respect to the arguments presented above, the “non-responsive” holding is maintained with respect to the April 21 Response.

## C O N C L U S I O N

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at [mfincham@walkerdigital.com](mailto:mfincham@walkerdigital.com).

**Fee Authorization and Petition for Extension of Time to Respond**

Applicants believe a two-month extension of time is required to make this response timely. Accordingly, Applicants hereby petition for a two-month extension of time and request that a \$225.00 fee for the two-month extension of time be charged to Applicants' Deposit Account 50-0271. If an additional fee and / or petition for an extension of time is required, please grant a petition for that extension of time which is required to make this Response timely and please charge Applicants' Deposit Account as appropriate.

Please charge as follows:

Charge: \$225.00

Deposit Account: 50-0271

Order No. 00-017

Credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

January 30, 2006  
Date

Respectfully submitted,



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